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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/696,872 | 10/30/2003 | Tsung-Tien Kuo | 930074-2013 | 9128 |
| 20999 | 7590 | 05/31/2006 | EXAMINER | |
| FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151 | | | | AHMAD, NASSER |
| ART UNIT | | PAPER NUMBER | | |
| | | 1772 | | |

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/696,872 | KUO ET AL. |
| | Examiner | Art Unit |
| | Nasser Ahmad | 1772 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 March 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 3-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 3-15 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 October 2003 is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Rejection Maintained

1. Claims 1 and 3-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Cho (WO-95/32491) for reasons of record made in the last Office Action of 10/24/2005.

Response to Arguments

2. Applicant's arguments filed March 6, 2006 have been fully considered but they are not persuasive.

Applicant argues that Cho fails to teach that the two pressure sensitive adhesives (PSA) are located on the back side or face of the marking face as is being claimed. This is not deemed to be convincing because Cho clearly teaches a sheet with two faces and one of the face is provided with two PSAs as is being claimed. As for the marking face being opposite to the adhesive face, applicant has failed to show that the opposite face (opposite from the adhesive face) of Cho would not be markable. Applicant is also informed that the instant claim 1 is directed to "a marking face" which is understood to be a face that is capable of receiving marking. Thus said "marking face" phrase is an intended future use of the sheet and, as explained in the last Office Action, intended use phrases have not been given any patentable weight because said phrases are not found to be of positive limitations. The intended use aspect is further supported by applicant's admission in the amendment, page-8, middle paragraph, wherein applicant states that "after the sheet member 31 is folded" and "the marking face...may be provided with marks", etc.

Also, in view of the above explanation, the prior art reference contains all the element of the claimed invention.

Thus, in the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention is anticipated by the prior art o record discussed above.

New ground of Rejection

3. The following is a new ground of rejection in view of the new claims 9-15 submitted on March 6, 2006.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cho (WO-95/32491).

Cho relates to a memo sheet comprising a sheet member (139) having a front side and a back side opposite to the front side, a fold line (174B) is formed on and dividing said sheet member into two parts, each part having a front face (not shown in figure-1A) and a back face (as can be seen), a first removable pressure sensitive adhesive (PSA) is provided on one of the back face of the two foldable parts, and a second removable

PSA is provided on the back face of the part that remains exposed when the sheet is folded. As shown in figure-1A, the first adhesive is located along line 147A (see lower 1/3rd of the sheet) and the second adhesive is located at or under element (174) adjacent the top of the sheet. As such the second adhesive will remain exposed. The dividing line can be a scored line, a weaken line, perforated line, etc. However, Cho fails to teach that the sheet is folded along the dividing line to form a hidden part. It would have been obvious to one having ordinary skill in the art to modify Cho by providing the sheet with the fold along the weakened dividing line, as it is well known in the art to fold a sheet along a weakened line, forming the hidden part.

It is understood by the examiner that the other face of the sheet of Cho, opposite to the adhesive face, is a marking face as it is capable of receiving markings because it is a paper sheet.

As shown in the figure-1A, the two adhesive are located adjacent to one another, the fold line is a marked line or a scored line (of perforations), the sheet has opposite side edges extending transverse to the fold line with the fold line extending from side to side and the side line forming the cutout portions.

Further, the hidden part has a smaller area than the cover part because the hidden part constitutes about 1/3rd of the sheet member.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1772

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nasser Ahmad 5/30/06
Nasser Ahmad
Primary Examiner
Art Unit 1772

N. Ahmad.
May 30, 2006.